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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/024,105

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Govindan Gopinathan

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3534

7590

11/02/2005

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EXAMINER

NASSER, ROBERT L

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/024,105	GOPINATHAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert L. Nasser	3736	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 17 October 2005.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1,4-21,24-29,33 and 37-79 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 77 is/are allowed.

6) ☒ Claim(s) 1,4-8,11,13-21,24-29,33,37-76,78 and 79 is/are rejected.

7) ☒ Claim(s) 9,10 and 12 is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All    b) ☐ Some \*    c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

The examiner notes that all of the current claims require at least 8 ekg sensors on one member. The parent applications only provide support for up to 6 on one member, with the other sensor on a second member. Therefore the current claims are not entitled to the filing date of the parent, and have only the current filing date, or December 18, 2001.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4, 5, 7, 10-15, 17-21, 24-29, 47, 70-72, 78, and 79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-94 of U.S. Patent No. 6224548 in view of David. The only difference in the current claims and the previous invention is that current claims require at least 7 electrodes. David shows a similar glove member with 12 EKG electrodes and other diagnostic devices. As such, it would have been obvious to modify the previous inventions to use 12 electrodes, as it is merely the substitution of one known diagnostic device for another. The exact arrangement of elements would have been obvious to one skilled in the art.

Claims 1, 4, 5, 7, 10-15, 17-21, 24-29, 47, 70-72, 78, and 79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-100 of U.S. Patent No. 6248064 in view of David. The only difference in the current claims and the previous invention is that current claims require at least 7 electrodes. David shows a similar glove member with 12 EKG electrodes and other diagnostic devices. As such, it would have been obvious to modify the previous inventions to use 12 electrodes, as it is merely the substitution of one known diagnostic device for another. The exact arrangement of elements would have been obvious to one skilled in the art.

Claims 1, 4, 5, 7, 10-15, 17-21, 24-29, 47, 70-72, 78, and 79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6540673 in view of David. The only difference in the current claims and the previous invention is that current claims require at least 7 electrodes. David shows a similar glove member with 12 EKG electrodes and other diagnostic devices. As such, it would have been obvious to modify the previous inventions to use 12 electrodes, as it is merely the substitution of one known diagnostic device for another. The exact arrangement of elements would have been obvious to one skilled in the art.

Claims 1-5, 7, 10-15, 17-21, 24-29, 47, 70-72, 78, and 79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-64 of U.S. Patent No. 6595918 in view of David. The only difference in the current claims and the previous invention is that current claims require at least 7

electrodes. David shows a similar glove member with 12 EKG electrodes and other diagnostic devices. As such, it would have been obvious to modify the previous inventions to use 12 electrodes, as it is merely the substitution of one known diagnostic device for another. The exact arrangement of elements would have been obvious to one skilled in the art.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 8, 16, 17, 33, 37-46, 48-69, and 73-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has recited in these claims that two of the electrodes face the dorsal surface of the member. It is unclear how one uses such electrodes to make an EKG measurement. In addition, it seems to contradict page 10 of the specification, where it states that the dorsally facing electrodes 40i and 40j are in the left and right shoulder quadrants. Clarification is required.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 78 and 79 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Both of these claims recite that the wrist portion does not extend over the entire forearm. However, this recites a positive relationship to the human body. The human body is non statutory and cannot be positively recited. Since these claims recite the body, the claims are non-statutory. Applicant should recite that the device is adapted to extend, or use similar language.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 7, 14, 15, 17-21, 24-29, 47, 70-72, 78, and 79 are rejected under 35 U.S.C. 102(e) as being anticipated by David. David shows a glove (the shown embodiments appear to be the glove/sleeve combination, but it does state that it may be incorporated into only a glove) combination including 4 phalange portions, as thumb portion, a wrist portion, a palmer portion, and a dorsal portion, with 11 electrodes (counting the one of the sling) mounted on the device, a device 24 for communicating with remote monitoring equipment, and other diagnostic devices including a temperature sensor 44, a blood pressure measuring device 16 and 18, a pulse oximeter 36, a heart beat detector 38, and an auscultation device 50 and 52. All of the

electrodes are on the palmer side of the glove (see column 5, line 54-58), with some on the wrist portion, some on the palmer surface and some on the phalange portions, including the pinky portion. Claims 70 and 71 are rejected in that David shows the recited method. Claims 78 and 79 are rejected in that the device fits as recited, depending on the size of the user.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over David. Claims 11 and 13 are rejected in that applicant has not stated that the arrangement of the electrodes on the member glove solves a stated problem and has not stated that the arrangement is for a specific purpose. In addition, applicant has not shown any unexpected results from the recited arrangement. Hence, it would have been obvious to modify David to locate the electrodes as claimed, as it is merely a matter of design choice for one skilled in the art.

Claims 9, 10, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 77 is allowable.

Claims 9, 10, 12, and 77 define over the art in that they recite that the index finger portion is at least as long as the middle finger portion. As applicant pointed out in his remarks, there is criticality to this design. None of the art shows this feature. As such, the claims define over the art.

Applicant's arguments filed 10/17/2005 have been fully considered but they are not persuasive.

With respect to the double patenting rejections, applicant has asserted that David is quite different than applicant's invention. While this may or may not be true, the Federal Circuit has clearly established that a reference is good for all it teaches. It is the examiner's position that David clearly teaches using a different number of ekg sensors than the prior invention.

Applicant has further argued that a sleeve and bicep portion do not make a wrist portion. The examiner disagrees. The term wrist portion is merely an intended use limitation, i.e. "a portion intended to lie against the wrist." In David, the sleeve and bicep portion is "adapted to lie against the wrist." As such, it is properly viewed as a wrist portion.

That being said, applicant has further argued that there are 5 sensors located on the sleeve and bicep portion of David and since there is no bicep portion in the prior invention, there is no motivation to combine the two references. The examiner notes that the Federal Circuit has established that references need not be bodily combined when making a combination. In the present case, David is cited to teach using 10 ekg



sensors on a body worn device. It is well within the ability of one skilled in the art to determine the proper arrangement of the sensors on the device of the prior invention.

Applicant has further argued that David makes no mention that it's arrangement maybe modified. The examiner notes that there is no requirement that David state that its arrangement may be modified for it to properly be used to modify another reference.

The examiner disagrees. Here, both the present invention and David teach glove members with ekg sensors thereon. As such, they are similar. It is within the ability of one skilled in the art to determine where to place the sensors. In addition, the examiner notes that the sleeve and bicep portion is the wrist portion in that it covers the wrist and other portions.

Applicant further argues that David has a very specific sensor arrangement that is different than applicant's. The sensor arrangement of David meets the claim language and, as such, the issue as to whether the overall arrangement is different is not relevant to prosecution.

In addition, applicant states that David does not teach that the present invention can be achieved. There is no requirement that David by itself teach the present invention.

With respect to the enablement rejection, applicant has provided a general explanation of how the sensors work. However, the issue is how the two specific sensors that face the dorsal surface work, 40i and 40j, as their operation is not described in the specification. The examiner sees wherein the specification the sensors 40i and 40j are discussed.

Applicant has stated that David does not provide an enabling disclosure of the glove embodiment. The examiner disagrees, noting that how to place the sensors on a glove within the knowledge of one skilled in the art.

In addition, applicant has noted that since David's device fits on the hand, forearm and arm, it is not a wrist portion. Again, as previously noted, the term wrist portion is an intended use limitation that is met by David. As such, the entire sleeve and bicep portion is the "wrist" portion and David meets the limitations of the claims.

Applicant has further noted that the prior art does not teach the features of claim 12. The examiner agrees and notes that claim 12 has been previously indicated to define over the prior art.

Applicant has stated that the features of claim 13 are not taught or suggested by the prior art. The examiner disagrees, for the reasons given above.

Applicant has further asserted that the blood pressure device of David is on the neck sling, which is separate from the sleeve. The examiner notes the neck sling is attached to the sleeve and hence they are a single device. Further, in column 3, David teaches that the blood pressure device is incorporated into the sleeve.

This is a RCE of applicant's earlier application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action

in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RLN  
October 28, 2005

Robert L. Nasser  
Primary Examiner  
Art Unit 3736



ROBERT L. NASSER  
PRIMARY EXAMINER